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09/711,049	11/09/2000	Masahito Niikawa	15162/02720	6084
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SIDLEY AUSTIN BROWN & WOOD LLP			DAMIANO, ANNE L	
717 NORTH HARWOOD			ART UNIT	
SUITE 3400			PAPER NUMBER	
DALLAS, TX 75201			2114	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,049

Applicant(s)

NIKAWA

Examiner

Anne L Damiano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/16/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14, 15, 18, 20-31 and 34-40 is/are rejected.
- 7) ☒ Claim(s) 11-13, 16, 17, 19, 32 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Allowable Subject Matter

1. Claims 11-13, 16, 17, 19, 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-10, 14, 18, 20, 21-27, 30, 31, 34 and 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Griffin et al. (6,442,714).

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As in claim 1, Griffin discloses a method of diagnosing an electronic device, which belongs to a customer, comprising the steps of:

a) Receiving an inspection result obtained by executing an inspection program on the electronic device on the customer's side under instruction from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4) (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing system receives the inspection results.); and

b) Obtaining a diagnosis result (report) by diagnosing said electronic device on the basis of the inspection result (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33 and column 6: lines 43-48). (The testing system uploads the test results, stores them in a database and produces reports.)

As in claim 2, Griffin discloses the method further comprising the step of supplying the inspection program to said customer before step a) (abstract: 2nd paragraph, lines 1-3 and column 1: lines 42-57).

As in claim 3, Griffin discloses the method further comprising the step of

c) Sending a computer-readable medium carrying the inspection program to the customer, wherein

Step c) is performed before step a) (column 1: lines 42-57 and column 4: lines 36-44).

As in claim 4, Griffin discloses the method further comprising the step of

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d) Sending the inspection program to the customer through computer communication, wherein

Step d) is performed before step a) (column 1: lines 42-57 and column 4: lines 36-44).

As in claim 5, Griffin discloses the method, wherein

The inspection program is registered on a server connected to a computer network (abstract, second paragraph, lines 1-3 and column 3: lines 23-34).

As in claim 6, Griffin discloses the method, wherein

A plurality of inspection programs is registered on the server in accordance with diagnostic items of the electronic device (abstract, second paragraph, lines 1-3 and column 4: lines 6-8 and lines 31-45).

As in claim 7, Griffin discloses

A computer-readable medium carrying the inspection result being received in step a) (column 1: lines 48-57). (The information is uploaded to the database of the testing system implying that the means in which the results were carried were computer-readable.)

As in claim 8, Griffin discloses

The inspection result being received through computer communication in step a) (column 1: lines 48-57).

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As in claim 9, Griffin discloses

Step a) including the step of confirming whether data received as an inspection result is a valid inspection result or not (column 3: line 64-column 4: line 5). (The user input and requested job information is interpreted as being part of the inspection program result.)

As in claim 10, Griffin discloses the method further comprising the step of

e) transmitting the diagnosis result to the customer (column 6: lines 36-48).

As in claim 14, Griffin discloses the method further comprising,

The diagnostic result including information which indicates whether the electronic device needs repair or not (column 1: lines 5-6 and lines 35-40). (A report produced from a compliance test will indicate whether the product is compliant or not. If it is noncompliant, it will need repair.)

As in claim 18, Griffin discloses

Step b) being performed by a computer (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33). (The testing system uploads the test results, stores them in a database and produces reports.)

As in claim 20, Griffin discloses a method of diagnosing an electronic device, which belongs to a customer, comprising the steps of:

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a) Receiving an inspection result carried in a computer readable medium, the inspection result obtained by executing an inspection program on the electronic device on the customer's side under instruction from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4) (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing system receives the inspection results.); and

b) Reading out the inspection result (report) from the computer-readable medium (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33 and column 6: lines 43-48). (The testing system uploads the test results, stores them in a database and produces reports. The user reads out the results that are displayed on the browser.)

As in claim 21, Griffin discloses the method further comprising the step of

c) Sending a computer-readable medium carrying the inspection program to the customer, wherein

Step c) is performed before step a) (column 1: lines 42-57 and column 4: lines 36-44).

As in claim 22, Griffin discloses a method of diagnosing an electronic device which belongs to a customer comprising the steps of:

a) receiving an inspection result through computer communication, the inspection result obtained by executing an inspection program on the electronic device on the customer's side under instructions from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4) (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing system receives the inspection results.); and

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b) preparing for reading out the inspection result (report) (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33 and column 6: lines 43-48). (The testing system uploads the test results, stores them in a database and produces reports. The user reads out the results that are displayed on the browser. The reports are prepared before they are sent out.)

As in claim 23, Griffin discloses the method further comprising the step of

c) Sending the inspection program to the customer through computer communication, wherein

Step c) is performed before step a) (column 1: lines 42-57 and column 4: lines 36-44).

As in claim 24, Griffin discloses the method further comprising the step of

d) Accepting selection of an inspection program out of a plurality of inspection programs from the customer; wherein

Step d) is performed before step c) (column 4: lines 6-12 and lines 31-45) .

As in claim 25, Griffin discloses a method of serving an inspection program for an electronic device which belongs to a customer through computer communication, the method comprising the steps of:

a) Registering a plurality of inspection programs on a server, the plurality of inspection programs corresponding to a plurality of functions of the electronic device, respectively (abstract, second paragraph, lines 1-3 and column 3: lines 23-34); (All of the tests reside on the central server. These tests were registered on the server at some point.)

b) Accepting selection of an inspection program out of the plurality of inspection programs from the customer (column 4: lines 6-8 and lines 31-45); and

c) Accepting download of the inspection program selected in step b)

Wherein the inspection program is adapted for execution on the electronic device on the customer's side under instruction from the customer (abstract: lines 1-8, column 1: lines 42-54).

As in claim 26, Griffin discloses a method of serving an inspection program for an electronic device which belongs to a customer, the method comprising the steps of:

a) Preparing an inspection program (column 4: lines 6-12 and lines 31-44); and

b) Supplying the inspection program to the customer, wherein

An inspection result is generated by execution of the inspection program on the electronic device on the customer's side under instruction from the customer, and diagnosis of the electronic device is performed on the basis of the inspection result (column 4: lines 47-52).

As in claim 27, Griffin discloses an apparatus for diagnosing an electronic device through computer communication, the electronic device belonging to a customer, the apparatus comprising;

A receiving circuit for receiving an inspection result obtained by executing an inspection program on the electronic device on the customer's side under instructions from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4); (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing

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system receives the inspection results, implying that the receiving circuit exists in the system.)
and

A processor for obtaining a diagnosis result by diagnosing the electronic device on the basis of the inspection result (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33 and column 6: lines 43-48). (The testing system uploads the test results, stores them in a database and produces reports. The user obtains these results, implying that a processor for obtaining these results exists in the system.)

As in claim 30, Griffin discloses

Step a) including the step of confirming whether data received as an inspection result is a valid inspection result or not (column 3: line 64-column 4: line 5). (The user input and requested job information is interpreted as being part of the inspection program result.)

As in claim 31, Griffin discloses the apparatus further comprising

A transmitting circuit for transmitting the diagnosis result toward the customer (column 6: lines 36-48). (The reports can be transmitted to the user's browser, implying that a transmitting circuit exists in the system.)

As in claim 34, Griffin discloses the apparatus further comprising

The diagnostic result including information which indicates whether the electronic device needs repair or not (column 1: lines 5-6 and lines 35-40). (A report produced from a compliance

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test will indicate whether the product is compliant or not. If it is noncompliant, it will need repair.)

As in claim 36, Griffin discloses an apparatus for serving an inspection program for an electronic device through computer communication, the electronic device belonging to a customer, the apparatus comprising:

A receiving circuit for receiving messages from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4); (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing system receives the inspection results, in the form of messages, implying that the receiving circuit exists in the system.) and

A processor for registering a plurality of inspection programs corresponding to a plurality of functions of the electronic device (abstract, second paragraph, lines 1-3 and column 3: lines 23-34); (All of the tests reside on the central server. These tests were registered on the server at some point, implying that a processor for registering the programs exists in the system.), respectively accepting selection of an inspection program out of the plurality of programs, and accepting download of the inspection program selected by the customer (column 4: lines 6-8 and lines 31-45),

Wherein the inspection program is adapted for execution on the electronic device on the customer's side under instruction from the customer (abstract: lines 1-8, column 1: lines 42-54).

As in claim 37, Griffin discloses a computer-readable medium carrying a program for diagnosing an electronic device through computer communication, the electronic device

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belonging to a customer, wherein execution of the program by a computer causes the computer to perform a process comprising the steps of:

a) Receiving an inspection result obtained by executing an inspection program on the electronic device on the customer's side under instructions from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4) (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing system receives the inspection results.); and

b) Obtaining a diagnosis result by diagnosing the electronic device on the basis of the inspection result (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33 and column 6: lines 43-48). (The testing system uploads the test results, stores them in a database and produces reports. The user obtains these results.)

As in claim 38, Griffin discloses a computer-readable medium being a hard disk system connected to a server on a computer network (column 1: lines 48-53).

As in claim 39, Griffin discloses a computer-readable medium carrying a program for serving an inspection program for an electronic device through computer communication, the electronic device belonging to a customer, wherein execution of the program by a computer causes the computer to perform a process comprising the steps of:

a) Registering a plurality of inspection programs on a server, the plurality of inspection programs corresponding to a plurality of functions of the electronic device, respectively

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(abstract, second paragraph, lines 1-3 and column 3: lines 23-34); (All of the tests reside on the central server. These tests were registered on the server at some point.)

b) Accepting selection of an inspection program out of the plurality of inspection programs from the customer (column 4: lines 6-8 and lines 31-45); and

c) Accepting download of the inspection program selected in step b)

Wherein the inspection program is adapted for execution on the electronic device on the customer's side under instruction from the customer (abstract: lines 1-8, column 1: lines 42-54).

As in claim 40, Griffin discloses a computer-readable medium being a hard disk system connected to a server on a computer network (column 1: lines 48-53).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin.

Regarding claim 15, Griffin discloses a method of diagnosing an electronic device, which belongs to a customer, the method comprising the steps of:

a) Receiving an inspection result obtained by executing an inspection program on the electronic device on the customer's side under instruction from the customer (abstract: lines 1-8, column 1: lines 42-54 and column 4: line 66-column 5: line 4) (The tests are performed by the user. The results are uploaded to the testing system. Therefore, the testing system receives the inspection results.); and

b) Obtaining a diagnosis result (report) by diagnosing said electronic device on the basis of the inspection result (column 1: lines 48-57, column 2: lines 2-4 and lines 27-33). (The testing system uploads the test results, stores them in a database and produces reports. The user obtains these results.)

Griffin discloses the diagnostic result including information which indicates whether the electronic device needs repair or not (column 1: lines 5-6 and lines 35-40). (A report produced from a compliance test will indicate whether the product is compliant or not. If it is noncompliant, it will need repair.) Griffin also discloses the diagnostic results being in the form of a detailed report, tailored for the equipment and test (column 1: lines 48-57).

However, Griffin does not specifically disclose the results including first, second and third states indicating if the electronic device is normal, has trouble but needs no repair or needs repair. It would have been obvious to a person skilled in the art at the time the invention was made to include such states the reports of Griffin's system. It would have been obvious because Griffin discloses detailed reports indicating product compliance. A person skilled in the art would have understood that Griffin's detailed reports include an indication of the state of the product, being normal, having problems but not needing repair and needing repair.

6. Claims 28, 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin as applied to claim 27 above.

Regarding claim 28, Griffin discloses the apparatus for diagnosing an electronic device with a processor for obtaining a diagnosis result on the basis of an inspection result above. Griffin discloses the diagnostic result including information which indicates whether the electronic device needs repair or not (column 1: lines 5-6 and lines 35-40). (A report produced from a compliance test will indicate whether the product is compliant or not. If it is noncompliant, it will need repair.) Griffin also discloses the diagnostic results being in the form of a detailed report, tailored for the equipment and test (column 1: lines 48-57).

However, Griffin does not specifically disclose the processor comparing a value included in the inspection result with a predetermined threshold value, thereby judging whether the electronic device needs repair or not. It would have been obvious to a person skilled in the art at the time the invention was made to compare a value included in the inspection result with a predetermined threshold value, to judge whether the electronic device needs repair or not in Griffin's system. It would have been obvious because comparing an obtained result to a threshold is a well-known method for diagnosing test results. A person skilled in the art would have understood that although that step was not specifically disclosed in Griffin's system, it was performed in producing the test reports.

Regarding claim 29, Griffin discloses the apparatus for diagnosing an electronic device with a processor for obtaining a diagnosis result on the basis of an inspection result above.

Griffin discloses the diagnostic result including information which indicates whether the electronic device needs repair or not (column 1: lines 5-6 and lines 35-40). (A report produced from a compliance test will indicate whether the product is compliant or not. If it is noncompliant, it will need repair.) Griffin also discloses the diagnostic results being in the form of a detailed report, tailored for the equipment and test (column 1: lines 48-57).

However, Griffin does not specifically disclose the processor calculating a value for diagnosis from the inspection result, and comparing the value for diagnosis with a predetermined threshold value, to thereby judging whether the electronic device needs repair or not. It would have been obvious to a person skilled in the art at the time the invention was made to calculate a value for diagnosis from the inspection result and compare the value with a predetermined threshold value, to judge whether the electronic device needs repair or not in Griffin's system. It would have been obvious because comparing an obtained result to a threshold is a well-known method for diagnosing test results. In order to perform said well-known, diagnostic comparison, some value must be calculated from the test results. A person skilled in the art would have understood that although these steps were not specifically disclosed in Griffin's system, they were performed in producing the test reports.

Regarding claim 35, Griffin discloses the apparatus for diagnosing an electronic device with a processor for obtaining a diagnosis result on the basis of an inspection result above. Griffin discloses the apparatus further comprising the diagnostic result including information which indicates whether the electronic device needs repair or not (column 1: lines 5-6 and lines 35-40). (A report produced from a compliance test will indicate whether the product is

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compliant or not. If it is noncompliant, it will need repair.) Griffin also discloses the diagnostic results being in the form of a detailed report, tailored for the equipment and test (column 1: lines 48-57).

However, Griffin does not specifically disclose the results indicating first, second and third states indicating if the electronic device is normal, has trouble but needs no repair or needs repair. It would have been obvious to a person skilled in the art at the time the invention was made to include such states the reports of Griffin's system. It would have been obvious because Griffin discloses detailed reports indicating product compliance. A person skilled in the art would have understood that surely Griffin's detailed reports include an indication of the state of the product, being normal, having problems but not needing repair and needing repair.

Response to Arguments

7. Applicant's arguments with respect to claims 1-11, 14, 15, 18, 20-32, 34-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See PTO-892

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne L Damiano whose telephone number is (703) 305-8010. The examiner can normally be reached on M-F 9-6:30 first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (703) 305-9713. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

ALD



SCOTT BADERMAN
PRIMARY EXAMINER